

REMARKS

This is a full and timely response to the outstanding final Office Action mailed July 31, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, and 33

Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* (U.S. Pat. No. 6,738,841) in view of *Eldridge, et al.* (“Eldridge,” U.S. Pat. No. 6,430,601). Applicant respectfully traverses this rejection.

1. The Wolff Reference

Wolff discloses a system that can be used to retrieve and print remote documents. In the system, a PDA 930 accesses a server 920 and receives a quote for a “contract” from the server. *Wolff*, column 8, lines 48-55. If after reviewing the quote the PDA user wishes to print out the contract, the user sends a request for the contract to a printer 250 that then retrieves the contract from the server 920 and prints it. *Wolff*, column 8, line 66 to column 9, line 14.

Significantly, Wolff says nothing about “synchronizing” a “list” of documents stored on a remote computer.

2. The Eldridge Reference

Eldridge discloses a mobile document paging service. *Eldridge*, Patent Title. Eldridge generally teaches the concept of a mail server. *Eldridge*, column 3, line 31.

3. Applicant's Claims

(a) Claims 1-2, 6-7, 9-10, 26, and 28-29

Independent claim 1 provides as follows (emphasis added):

1. A method performed on an information appliance for printing a document stored on a remote computer, the method comprising:

providing a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;

receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;

displaying the updated list of user mailbox documents to the user on a display of the information appliance;

receiving a selection of one or more documents from the displayed list of user mailbox documents;

receiving a command to print the one or more selected documents; and

responsive to receiving the command to print, transmitting a print request to a nearby printer that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

In the Office Action, the Examiner argues that Wolff teaches or suggests every limitation of claim 1, with the exception of documents being stored in a mailbox and served by a mailbox server.

See *Final Office Action*, pages 1-4. In drawing that conclusion, the Examiner relies upon the disclosure provided in relation to Wolff's columns 8 and 9 and Figure 9. Applicant disagrees with the conclusion that Wolff teaches or suggests the other limitations of claim 1 for reasons described below.

In claim 1, Applicant claims a method in which a list of the user's documents stored on an "information appliance" are "synchronized" with a list of the user's documents stored on a remote computer before the user instructs a local printer to retrieve a document from the remote computer for printing. Wolff, however, teaches nothing of the sort. In view of that fact, Wolff does not, as is argued by the Examiner, teach any of:

- (i) "transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer",

- (ii) "receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing",

- (iii) "updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer", or

- (iv) "displaying the updated list of user mailbox documents to the user on a display of the information appliance".

With regard to the "transmitting information" limitation, the Examiner argues that Wolff teaches transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer because Wolff's PDA can "select one or more quotes/document" from a remote computer. *Final Office Action*,

page 2. Applicant notes that “selecting” quotes *from* a remote computer clearly does not equate to “transmitting” a list of documents stored on an information appliance from the application *to* the remote computer. Therefore, the Examiner’s argument regarding that limitation is without merit.

In the final Office Action, the Examiner states that the Examiner interprets transmitting information regarding a list of user mailbox documents from the information appliance to the remote computer as a “request to print.” *Final Office Action*, page 10. In response, Applicant asserts that the Examiner’s interpretation is neither supported by the plain and ordinary meaning of the claim limitation nor Applicant’s specification that is to be used to interpret the claim limitations. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff’d*, 517 U.S. 370, 38 USPQ2d 1461 (1996) (“Claims must be read in view of the specification, of which they are a part”). Simply stated, “requesting printing” cannot reasonably be considered transmitting a list of documents. Communicating a desire to print a document, even if identifying that document in the process, is not transmitting a “list of documents”.

Regarding the “receiving synchronization information” limitation, the Examiner argues that Wolff teaches receiving information from the remote computer. *Final Office Action*, page 2. Applicant asserts, however, that merely receiving “information” generally, and quotes in particular, is *not* equivalent to receiving “synchronization” information, either within the plain and ordinary meaning of the term “synchronization” or within the meaning provided by Applicant’s specification. Applicant notes that it is well established in the law that claim terms are to be *interpreted in light of the specification*. *Markman*, 52 F.3d 967, 34 USPQ2d 1321.

Next, regarding “updating the list” limitation, the Examiner argues that Wolff teaches “accessing” a home page and that each time the page is accessed, it is “updated.” *Final Office Action*, page 3. Applicant asserts that the Examiner is ignoring explicit claim terms of Applicant’s claim. Specifically, Applicant is not merely describing updating or refreshing a web page, but is explicitly claiming “updating [a] list of user mailbox documents stored on the information appliance”. Wolff, who is not concerned with synchronization at all, clearly does not teach updating a “list” of documents that is “stored on” an information appliance.

In the final Office Action, the Examiner states that because Wolff teaches displaying a web page on Wolff’s information device, the information device receives “synchronization information” and “updating the list of user mailbox documents stored on the information appliance using the synchronization information”. *Final Office Action*, page 11. In response, Applicant notes that the synchronization information is being used to update, or “synchronize,” the list of documents that the information appliance already *transmitted* to the remote computer. Even assuming that refreshing a web page is “updating” the information presented in the web page, Wolff clearly does not teach updating a “list of documents” that was “transmitted” from an information appliance to a remote computer.

Finally, regarding the “displaying the updated list” limitation, Applicant notes that since no “list of user mailbox documents” is “updated” in Wolff’s process, it logically follows that Wolff does not, as is argued by the Examiner, teach displaying such an “updated list” on an information appliance.

Given that Eldridge also fails to teach the above-described limitations, claim 1, and its dependents, are allowable over the Wolff/Eldridge combination.

Regarding dependent claim 26, neither Wolff or Eldridge teach that the “information” transmitted from the information appliance to the remote computer is a “list of user mailbox documents”, the list being stored on the information appliance. Again, no list is transmitted from Wolff’s information appliance to a remote computer. Further, no list identifying “user mailbox documents” is transmitted.

Regarding dependent claim 28, neither Wolff nor Eldridge teach that the “references to documents” received by the information appliance from the remote computer comprises one or more of “a Universal Resource Locator (URL), filename, reference number, and an identification number.” Applicant notes that although column 8, lines 25-30 generally identify a list of URLs, that list is merely a “table of contents” of information that can be accessed, not “references to documents” that are available for printing.

(b) Claims 15-17, 21, 23-25, 30, and 32-33

Independent claim 15 provides as follows (emphasis added):

15. A computer-readable storage medium having stored thereon computer instructions that, when executed by an information appliance, cause the information appliance to:

provide a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmit information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;

receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;

display the updated list of user mailbox documents to a user on a display of the information appliance;

receive a selection of one or more documents from the displayed list of user mailbox documents;

receive a command to print the one or more selected documents; and

transmit a print request to a nearby printer in response to receiving the command to print that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

Regarding claim 15, Wolff and Eldridge fail to teach or suggest a computer-readable medium that causes an information appliance to (i) “transmit information regarding a list of documents stored on the information appliance from the information appliance to the remote computer”, (ii) “receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing”, (iii) “update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer”, or (iv) “display the updated list of user mailbox documents to a user on a display of the information appliance” for reasons described in relation to claim 1 above. Applicant therefore submits that claim 15 and its dependents are allowable over the Wolff/Eldridge combination.

Regarding dependent claim 32, Applicant refers to the discussions of claims 28, which comprises similar limitations.

B. Rejection of Claims 3 and 22

Claims 3 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* as applied to claims 1, 2, 15, and 21, and in view of *Dalton* (U.S. Pat. No. 6,246,211). Applicant respectfully traverses this rejection.

As an initial matter, Applicant notes for the second time that the rejection is improper given that claims 1 and 15 were rejected in view of Wolff and Eldridge. Given that Eldridge is not cited against claims 3 and 22, the rejection is improper and should be withdrawn and a proper rejection should be presented in a further non-final Office Action.

As a further matter, Applicant notes that Wolff does not teach several aspects of Applicant's claims 1 and 15. In that Dalton does not remedy the deficiencies of the Wolff reference, Applicant submits that claims 3 and 22, which depend from claims 1 and 15, respectively, are allowable over the Wolff/Dalton combination for at least the same reasons that claims 1 and 15 are allowable over Wolff.

C. Rejection of Claims 27 and 31

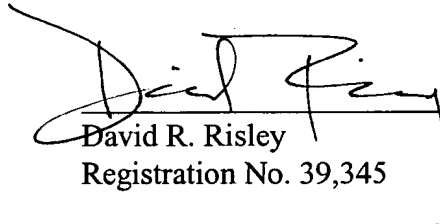
Claims 27 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* and *Eldridge* as applied to claims 1 and 15, and in view of *Granstam* (U.S. Pat. No. 6,587,691). Applicant respectfully traverses this rejection.

Applicant notes that Wolff and Eldridge do not teach several aspects of Applicant's claims 1 and 15. In that Granstam does not remedy the deficiencies of the Wolff and Eldridge references, Applicant submits that claims 27 and 31, which depend from claims 1 and 15, respectively, are allowable over the Wolff/Eldridge/Granstam combination for at least the same reasons that claims 1 and 15 are allowable over Wolff/Eldridge.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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9-7-06
Mary Meegan
Signature